

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): RONALD E. DELUGA

Confirmation No.: 4763

Application No.: 10/737,051

Examiner: CHANG, YEAN HSI

Filing Date: 12/16/2003

Group Art Unit: 2835

Title: LATCH ASSEMBLY THAT FACILITATES THE INSERTION AND REMOVAL OF A BATTERY MODULE FROM AN ELECTRONIC DEVICE

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
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TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 03/23/2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

() one month	\$120.00
() two months	\$450.00
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() four months	\$1590.00

() The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of \$500.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

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By *Tait R. Swanson*

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Ronald E. DeLuga

Serial No.: 10/737,051

Filed: December 16, 2003

For: Latch Assembly That Facilitates the
Insertion and Removal of a Battery
Module From an Electronic Device

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Group Art Unit: 2835

Examiner: Chang, Yean Hsi

Atty. Docket: 200302301-2
COMP:0263-1
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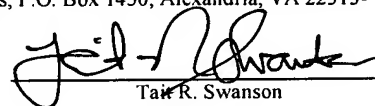
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Tair R. Swanson

Sir:

APPEAL BRIEF PURSUANT TO 37 C.F.R. §§ 41.31 AND 41.37

This Appeal Brief is being filed in furtherance of the Notice of Appeal mailed on March 23, 2005, and received by the Patent Office on March 28, 2005.

The Commissioner is authorized to charge the requisite fee of \$500.00, and any additional fees which may be necessary to advance prosecution of the present application, to Account No. 08-2025, Order No. 200302301-1/FLE (COMP:0263-1).

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1. **REAL PARTY IN INTEREST**

The real party in interest is Hewlett-Packard Development Company, L.P., a Texas Limited Partnership having its principal place of business in Houston, Texas and the Assignee of the above-referenced application. The Assignee of the above-referenced application will be directly affected by the Board's decision in the pending appeal.

2. **RELATED APPEALS AND INTERFERENCES**

Appellant is unaware of any other appeals or interferences related to this Appeal. The undersigned is Appellant's legal representative in this Appeal.

3. **STATUS OF CLAIMS**

Claims 1-42 are currently pending, are currently under final rejection and, thus, are the subject of this appeal.

4. **STATUS OF AMENDMENTS**

No claims have been amended since the final rejection. As such, there are no outstanding amendments to be considered by the Board.

5. **SUMMARY OF CLAIMED SUBJECT MATTER**

The present application is directed towards a technique that facilitates the insertion and removal of a battery module from an electronic device. Page, 3, lines 14-16. As described in the background section of the present application, in previous designs, movement of a latch could propel a battery to a lifted position, but the battery would return to its recessed position upon release of the latch. *See* page 3, lines 4-7. As such, in previous designs, the removal of a battery was a "two-handed" operation "in which one hand actuates and holds the latch mechanism while the other hand is used to grip and remove the battery." Page 3, lines 7-10. Embodiments of the technique recited in this application are directed towards simplifying this procedure. Page 3, lines 10-11.

With regard to the features set forth in independent claim 1, discussions of the recited features of claim 1 can be found at least in the locations in the specification and drawings cited below. By way of example, certain aspects of these claims relate to a component (e.g.,

42) mount for a computer (e.g., 10). *See, e.g.*, page 8, lines 4-17; *see also*, Fig. 2. The component mount comprises a component latch (e.g., 48) movable between a latched configuration and an unlatched configuration. *See, e.g.*, page 9, lines 9-20. The component mount also includes a plurality of bosses (e.g., 80). *See, e.g.*, page 10, lines 11-24. Further, the component mount comprises a lifter (e.g., 74) engageable with the plurality of bosses to move a component to a lifted position in the unlatched configuration, wherein the plurality of bosses comprise a retention structure (e.g., 84) retainable against a mating retention structure (e.g., 78) of the lifter to retain the component in the lifted position. *See, e.g.*, page 11, lines 4-12; *see also*, Fig. 6.

With regard to the features set forth in independent claim 7, discussions of the recited features of claim 7 can be found at least in the locations in the specification and drawings cited below. By way of example, certain aspects of these claims relate to component (e.g., 42) mount for a computer (e.g., 10). *See, e.g.*, page 8, lines 4-17; *see also*, Fig. 2. The component mount comprises a component latch (e.g., 48) movable between a latched configuration and an unlatched configuration. *See, e.g.*, page 9, lines 9-20. The component mount also includes a lifter (e.g., 74) having a sloped structure (e.g., 76) leading to an inwardly angled structure (e.g., 78). *See, e.g.*, page 10, lines 11-24; *see also*, Figs. 5 and 6. The component mount also comprises a boss (e.g., 80) movable along the sloped structure to a lifted position at the inwardly angled structure, whereat a mating angled structure (e.g., 84) of the boss is retainable against the inwardly angled structure. *See, e.g.*, page 11, lines 4-12; *see also*, Fig. 6.

With regard to the features set forth in independent claim 14, discussions of the recited features of claim 14 can be found at least in the locations in the specification and drawings cited below. By way of example, certain aspects of these claims relate to a removable computer component (e.g., 42). *See, e.g.*, page 7, line 18 – page 8, line 2; *see also*, Fig. 4. This removable computer component comprises a component housing insertable into a receptacle (e.g., 44) of a computer chassis (e.g., 18). *See id.* The removable computer component also comprises a component mount at least partially disposed on the component

housing and at least partially mountable in the computer chassis. *See, e.g.*, page 8, lines 4-17. The component mount comprises a component latch (e.g., 48) movable between a latched configuration and an unlatched configuration. *See, e.g.*, page 9, lines 1-7. The component mount also includes a lifter (e.g., 74) having a sloped structure (e.g., 76) leading to an angled retention structure (e.g., 78). *See, e.g.*, page 10, lines 11-24; *see also*, Figs. 5 and 6. The component mount further comprises a boss (e.g., 80) movable along the sloped structure to a lifted position at the angled retention structure, whereat a mating angled structure (e.g., 84) of the boss is retainable against the angled retention structure. *See, e.g.*, page 11, lines 4-12; *see also*, Fig. 6.

With regard to the features set forth in independent claim 20, discussions of the recited features of claim 20 can be found at least in the locations in the specification and drawings cited below. By way of example, certain aspects of these claims relate to a removable computer component (e.g., 42). *See, e.g.*, page 7, line 18 – page 8, line 2; *see also*, Fig. 4. The removable computer component comprises a component housing insertable into a receptacle (e.g., 44) of a computer chassis (e.g., 18). *See id.* The removable computer component also comprises a component mount at least partially disposed on the component housing and at least partially mountable in the computer chassis. *See, e.g.*, page 8, lines 4-17. The component mount comprises a latching mechanism (e.g., 48) movable to latch and unlatch the component housing with the receptacle. *See, e.g.*, page 9, lines 1-7. The component also includes a plurality of bosses (e.g., 80) movable by a lifting mechanism (e.g., 74) to move the component housing to a lifted position, whereat retention structures are engageable to support the component housing in the lifted position. *See, e.g.*, page 11, lines 4-12; *see also*, Fig. 6

With regard to the features set forth in independent claim 22, discussions of the recited features of claim 22 can be found at least in the locations in the specification and drawings cited below. By way of example, certain aspects of these claims relate to a computer chassis (e.g., 18). *See, e.g.*, page 7, line 18 – page 8, line 2; *see also*, Fig. 4. The computer chassis comprises a recessed structure (e.g., 44) adapted to receive a computer component (e.g., 42). *See id.* The computer chassis also includes a component mount at least partially positioned in the recessed structure and at least partially mountable to the computer

component. *See, e.g.*, page 8, lines 4-17. The component mount comprises a component latch (e.g., 48) movable between a latched configuration and an unlatched configuration. *See, e.g.*, page 9, lines 1-7. The component mount also includes a lifter (e.g., 74) having a sloped structure (e.g., 76) leading to an angled retention structure (e.g., 78). *See, e.g.*, page 10, lines 11-24; *see also*, Figs. 5 and 6. The component mount also comprises a boss (e.g., 80) movable along the sloped structure to a lifted position at the angled retention structure, whereat a mating angled structure (e.g., 84) of the boss is retainable against the angled retention structure. *See, e.g.*, page 11, lines 4-12; *see also*, Fig. 6.

With regard to the features set forth in independent claim 29, discussions of the recited features of claim 29 can be found at least in the locations in the specification and drawings cited below. By way of example, certain aspects of these claims relate to a computer chassis (e.g., 18). *See, e.g.*, page 7, line 18 – page 8, line 2; *see also*, Fig. 4. The computer chassis also comprises a recessed structure (e.g., 44) adapted to receive a computer component (e.g., 42). *See id.* The computer chassis also includes a component mount at least partially positioned in the recessed structure and at least partially mountable to the computer component. *See, e.g.*, page 8, lines 4-17. The component mount comprising a latching mechanism (e.g., 48) adapted to latch and unlatch the computer component with the recessed structure. *See, e.g.*, page 9, lines 1-7. The component mount also comprises a plurality of bosses (e.g., 80) movable by a lifting mechanism (e.g., 74) to move the component housing to a lifted position, whereat retention structures (e.g., 78 and 82) are engageable to support the component housing in the lifted position. *See, e.g.*, page 11, lines 4-12; *see also*, Fig. 6.

6. **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

First Ground of Rejection for Review on Appeal:

Appellant respectfully urges the Board to review and reverse the Examiner's first ground of rejection in which the Examiner rejected claims 7-11, 14-17, 22-27, 36-37, and 40 under 35 U.S.C. § 102(b) as being anticipated by Ohgami et al. (U.S. Patent No. 5,764,477, hereafter "the Ohgami reference").

Second Ground of Rejection for Review on Appeal:

Appellant respectfully urges the Board to review and reverse the Examiner's second ground of rejection in which the Examiner rejected claims 1-6, 20-21, 29-32, 33-35, 38-39, and 41-42 as being unpatentable over the Ohgami reference.

7. **ARGUMENT**

As discussed in detail below, Appellant believes that the Examiner has expended unnecessary time and resources, both of the Patent Office and Appellant, with unreasonable rejections and incomplete readings of the prior art and the present claims. In the Final Office Action, the Examiner's Section 102 rejections clearly misinterpret certain claim features, such as the "inwardly angled structure" of independent claim 7. Further, the Examiner has misinterpreted the Ohgami reference. As discussed in detail below, the Ohgami reference discloses a *convex* portion 42 that moves along cam surface 65 to a *concave* cavity 67. *See* Fig.18B; col. 9, line 62 – col. 10, line 5. In addition, the Examiner's Section 103 rejections clearly misinterpret longstanding legal precedent regarding the duplication of parts. In view of these misinterpretations, the Appellant emphasizes that the Examiner has failed to interpret the claims in a *reasonable* manner, which is *consistent* with regard to the scope of the present application and with regard to the interpretation that those of ordinary skill in the art would reach. *See In re Cortright*, 165 F.3d 1353, 1359, 49 *U.S.P.Q.*2d 1464, 1468 (Fed. Cir. 1999). For these reasons, as set forth in further detail below, Appellant respectfully requests that the Board find claims 1-42 patentable over the prior art of record and withdraw all outstanding rejections.

A. **First Ground of Rejection**

The Examiner rejected claims 7-11, 14-17, 22-27, 36-37, and 40 under 35 U.S.C. § 102(b) as being anticipated by the Ohgami reference. Appellant respectfully traverses these rejections. Each of the independent claims will be discussed separately below.

1. **Judicial precedent has clearly established a legal standard for a prima facie anticipation rejection.**

First, anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir. 1985). Thus, for a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Moreover, the prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Accordingly, Appellants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

Second, when construing claims, the Federal Circuit has consistently looked first to dictionaries, encyclopedias, and treatises, which were publicly available at the time the patent issued, to determine the ordinary and custom meanings of terms used in claims. As stated in *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202-03 (Fed. Cir. 2002):

Such references are unbiased reflections of common understanding not influenced by expert testimony or events subsequent to the fixing of the intrinsic record by the grant of the patent, not colored by the motives of the parties, and not inspired by litigation. Indeed, these materials may be the most meaningful source of information to assist judges in better understanding both the technology and the terminology used by those skilled in the art to describe the technology.

The *Texas Digital* court further stated that “[c]onsulting the written description and prosecution history as a threshold step in the claim construction process, before any effort is made to discern the ordinary and customary meanings attributed to the words themselves, invites a violation of our precedent counseling against importing limitations into the claims.” *Id.* at 1204 (cited with approval in *Intellectual Property Development Inc. v. UA-Columbia Cablevision of Westchester Inc.*, 67 U.S.P.Q. 2d 1385, 1389 (Fed. Cir. 2003)).

2. **The Examiner's rejection of independent claim 7 is improper because the rejection fails to establish a prima facie case of anticipation.**

Independent claim 7 recites:

A component mount for a computer, comprising:
a component latch movable between a latched configuration and an unlatched configuration;
a lifter having a sloped structure leading to an inwardly angled structure; and
a boss movable along the sloped structure to a lifted position at the inwardly angled structure, whereat a mating angled structure of the boss is retainable against the inwardly angled structure.

In rejecting independent claim 7, the Examiner asserted that the Ohgami reference discloses all of the recited features of the claim. *See* Final Office Action mailed February 1, 2005, page 3. Appellant respectfully traverses this assertion.

As discussed above, the present application is directed towards a technique that facilitates the insertion and removal of a battery module from an electronic device. Page, 3, lines 14-16. Accordingly, independent claim 1 recites a component mount for a computer comprising “a lifter having a sloped structure leading to an *inwardly angled structure*” and “a mating *angled structure* of the boss.” (Emphasis added). In sharp contrast, the Ohgami reference discloses a *convex* portion 42 that moves along *cam* surface 65 to a *concave* cavity 67. *See* Fig. 18B; col. 9, line 62 – col. 10, line 5. Appellant submits to the Board that “angled” may be defined as “having an angle or angles” and that “angle” may be defined as “the space within two or more lines or three or more planes diverging from a common point.” THE RANDOM HOUSE COLLEGE DICTIONARY 51-52 (Rev. Ed. 1988). In sharp contrast, the term “convex” is defined as “having a surface that is curved or rounded out.” *Id.* at 294. In further contrast, the term “concave” is defined as “curved like a segment of the interior of a circle or hollow sphere; hollow or curved.” *Id.* at 277. Finally, the term “cam” is defined as “an irregularly shaped *disk or cylinder* that imparts a rocking motion to any contiguous part.” *Id.* at 194 (emphasis added). Clearly, these disclosed terms are limited to curved (not angled) surfaces that enable *rolling movement* in a semi-circular manner, which never completely retains or prevents further motion. For at least these reasons, Appellant asserts that neither

the convex portion 42 nor the cavity 67 disclosed in the Ohgami reference can be considered the angled structures recited in claim 7. For at least these reasons, Appellant respectfully asserts that the Examiner has clearly not established a *prima facie* case of anticipation with regard to claim 7 and its dependent claims. Accordingly, Appellant respectfully requests that the Board overturn the rejection and allow independent claim 7 and the claims that depend therefrom.

3. **The Examiner's rejection of dependent claim 10 is improper because the rejection fails to establish a prima facie case of anticipation.**

Dependent claim 10 recites:

The component mount of claim 7, wherein the inwardly angled structure and the mating angled structure comprise substantially flat abutment surfaces that are substantially angled relative to a direction of movement between the inwardly angled structure and the mating angled structure.

In rejecting dependent claim 10, the Examiner asserted that the Ohgami reference discloses all of the recited features of the claims. *See* Official Action mailed February 1, 2005, page 3. Appellant respectfully traverses this assertion.

As discussed above, the present application is directed towards a technique that facilitates the insertion and removal of a battery module from an electronic device. Page, 3, lines 14-16. As such, dependent claim 10 recites the component mount of independent claim 7, wherein “the inwardly angled structure and the mating angled structure comprise *substantially flat abutment* surfaces that are *substantially angled relative* to a direction of movement.” (Emphasis added). Appellant submits to the Board that “flat” may be defined as “horizontally level” or as “having a surface that is without marked projections or depressions” THE RANDOM HOUSE COLLEGE DICTIONARY 502 (Rev. Ed. 1988). As described above, however, the Ohgami reference discloses a *convex* portion 42 that moves along cam surface 65 to a *concave* cavity 67. *See* Fig. 18B; col. 9, line 62 – col. 10, line 5. Appellant submits to the Board that neither the convex portion 42 nor the concave cavity 67 (which were cited by the Examiner) can be considered to be “substantially angled *relative to the direction of movement*,” as recited in claim 10 (emphasis added). In fact, it is quite clear

from Fig. 11 of the Ohgami reference, which was cited by the Examiner, that the concave cavity 67 is neither “substantially *flat*” nor “substantially *angled* relative to the direction of movement.” In other words, contrary to the Examiner’s assertion, it is clear that a mating semi-circular surfaces (e.g., the convex portion 42 and the concave cavity 67) cannot be considered to be “substantially flat” and “substantially angled relative to the direction of movement,” as recited in claim 10. Again, the semi-circular surfaces define and enable a curved path of travel and thus, can never be angled relative to the direction of movement. For this reason, in addition to the reasons set forth above in regard to independent claim 7, Appellant respectfully asserts that the Examiner has clearly not established a *prima facie* case of anticipation with regard to claim 10. Accordingly, Appellant respectfully requests that the Board overturn the rejection and allow dependent claim 10.

4. **The Examiner’s rejection of independent claim 14 is improper because the rejection fails to establish a prima facie case of anticipation.**

Independent claim 14 recites:

A removable computer component, comprising:

a component housing insertable into a receptacle of a computer chassis; and

a component mount at least partially disposed on the component housing and at least partially mountable in the computer chassis, the component mount comprising:

a component latch movable between a latched configuration and an unlatched configuration;

a lifter having a sloped structure leading to an angled retention structure; and

a boss movable along the sloped structure to a lifted position at the angled retention structure, whereat a mating angled structure of the boss is retainable against the angled retention structure.

The Ohgami reference fails to disclose every element of independent claim 14.

Appellant notes that independent claim 14 recites “a lifter having a sloped structure leading to

an *angled retention structure*” and “a boss movable along the sloped structure to a lifted position at the angled retention structure, whereat a mating angled structure of the boss is retainable against the angled retention structure.” (Emphasis added). As summarized above with respect to the improper rejection of claim 7, the arguments for which are incorporated herein by reference, the Ohgami reference does not disclose the above-recited claim features of independent claim 14.

Because the reference fails to disclose each element recited by the instant claim, the Ohgami reference fails to anticipate independent claim 14. Thus, the Examiner’s rejection of independent claim 14, and the claims depending therefrom, is clearly improper. Accordingly, Appellant requests that the Board overturn the rejection and allow independent claim 14 and the claims that depend from it.

5. **The Examiner’s rejection of dependent claim 17 is improper because the rejection fails to establish a prima facie case of anticipation.**

Dependent claim 17 recites:

The removable computer component of claim 14, wherein the angled retention structure and the mating angled structure comprise substantially parallel abutment surfaces.

In rejecting dependent claim 17, the Examiner asserted that the Ohgami reference discloses all of the recited features of the claims. *See* Official Action mailed February 1, 2005, page 4. Appellant respectfully traverses this assertion.

As discussed above, the present application is directed towards a technique that facilitates the insertion and removal of a battery module from an electronic device. Page, 3, lines 14-16. Accordingly, dependent claim 10 recites the component mount of independent claim 14, wherein “the angled retention structure and the mating angled structure comprise *substantially parallel* abutment surfaces.” (Emphasis added). Appellant submits to the Board that “parallel” may be defined as “extending in the same direction, equidistant at all points, and never converging or diverging: *parallel rows of tree*” or as “lying in the same plane but never meeting no matter how far extended.” THE RANDOM HOUSE COLLEGE DICTIONARY 964

(Rev. Ed. 1988) (emphasis in original). As described above, however, the Ohgami reference discloses a *convex* portion 42 that moves along cam surface 65 to a *concave* cavity 67. See Fig. 18B; col. 9, line 62 – col. 10, line 5. Appellant submits to the Board that the convex portion 42 and the concave cavity 67 (which were cited by the Examiner) can not be considered to be “substantially parallel,” to one another as asserted by the Examiner. In other words, contrary to the Examiner’s assertion, Appellant asserts that two *circular* surfaces (the convex portion 42 and the concave cavity 67) can simply not be considered to disclose “substantially parallel abutment surfaces,” as recited in claim 17. For this reason, in addition to the reasons set forth above in regard to independent claim 14, Appellant respectfully asserts that the Examiner has clearly not established a *prima facie* case of anticipation with regard to claim 17. Accordingly, Appellant respectfully requests that the Board overturn the rejection and allow dependent claim 17.

6. **The Examiner’s rejection of independent claim 22 is improper because the rejection fails to establish a prima facie case of anticipation.**

Independent claim 22 recites:

A computer chassis, comprising:

a recessed structure adapted to receive a computer component;

a component mount at least partially positioned in the recessed structure and at least partially mountable to the computer component, the component mount comprising:

a component latch movable between a latched configuration and an unlatched configuration;

a lifter having a sloped structure leading to an angled retention structure; and

a boss movable along the sloped structure to a lifted position at the angled retention structure, whereat a mating angled structure of the boss is retainable against the angled retention structure.

The Ohgami reference fails to disclose every element of independent claim 22.

Appellant notes that independent claim 22 recites “a lifter having a sloped structure leading to

an *angled retention structure*” and “a boss movable along the sloped structure to a lifted position at the angled retention structure, whereat a mating angled structure of the boss is retainable against the angled retention structure.” (Emphasis added). As summarized above with respect to the improper rejection of claim 7, the arguments for which are incorporated herein by reference, the Ohgami reference does not disclose the above-recited claim features of independent claim 22.

Because the reference fails to disclose each element recited by the instant claim, the Ohgami reference fails to anticipate independent claim 22. Thus, the Examiner’s rejection of independent claim 22, and the claims depending therefrom, is clearly improper. Accordingly, Appellant requests that the Board overturn the rejection and allow independent claim 22 and the claims that depend from it.

B. Second Ground of Rejection

The Examiner rejected claims 1-6, 20-21, 29-32, 33-35, 38-39, and 41-42 as being unpatentable over the Ohgami reference. Appellant respectfully traverses these rejections.

1. Judicial precedent has clearly established a legal standard for a *prima facie* obviousness rejection.

First, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (B.P.A.I. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes all of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must

suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Second, Appellant notes that there is no *per se* rule that duplication of parts is obvious. In order to establish a *prima facie* case of obviousness, the Examiner must explain why the “reference itself would have fairly suggested, to one of ordinary skill in the art, the desirability” of the duplication. *See Ex Parte Granneman*, 68 U.S.P.Q.2d 1219 (Bd. Pat. App. & Inter. 2003). The mere fact that the prior art could be modified as proposed by the examiner is *simply not sufficient* to establish a *prima facie* case of obviousness. *See In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

Third, as the Board is aware, when prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

23. The Examiner’s rejections of independent claims 1-6, 20-21, 29-32, 33-35, 38-39, and 41-42 are improper because the rejections fail to establish a prima facie case of obviousness.

The Examiner rejected claims 1-6, 20-21, 29-32, 33-35, 38-39, and 41-42 as being unpatentable over the Ohgami reference. Appellant respectfully traverses these rejections. In the Final Office Action mailed February 1, 2005, the Examiner conceded that the sole cited reference does *not* disclose all of the recited features of the claims 1-6, 20-21, 29-32, 33-35, 38-39, and 41-42. *See* Final Office Action, pages 7, 8, and 9. That is, even assuming that the Examiner’s interpretation of the Ohgami reference is correct, the Examiner nonetheless expressly conceded that Ohgami does not disclose an additional boss and an additional lifter.” *See id.* However, to satisfy this deficiency, the Examiner, in a conclusory manner, asserted that “[i]t would have been obvious...to modify the device of Ohgami with

an additional boss and an additional lifter...since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art.” Page 7, lines 11-16.

As support for this proposition, the Examiner cited Section 2144.04 (VI)(B) of the M.P.E.P. Appellant, however, respectfully asserts that the Examiner has *misapplied* this section of the M.P.E.P. to establish a *per se* rule that duplication of parts involves only routine skill in the art. In contrast, the Board has recently made it clear that the both M.P.E.P. §2144.04 and *In re Harza* (the case upon which M.P.E.P. §2144.04(VI)(B) is based) *does not* establish a *per se* rule that duplication of parts is obvious. *See Ex Parte Granneman*, 68 U.S.P.Q.2d 1219, 1220 (Bd. Pat. App. & Inter. 2003); *see also In re Ochiai*, 37 U.S.P.Q.2d 1127, 1133 (Fed. Cir. 1995) (holding that “reliance on per se rules of obviousness is legally incorrect and must cease.”). With this in mind, Appellant respectfully asserts that the Examiner’s conclusory statement does not *demonstrate* that a “plurality of bosses,” as recited in independent claims 1, 20, or 29 are either obvious or well known in the art.

Furthermore, the Examiner does not assert that the Ohgami reference contains any motivation or suggestion to modify the device disclosed therein to reach the claimed subject matter. In fact, the Examiner has not presented any *objective evidence* of the requisite motivation or suggestion to modify the Ohgami reference that could lead the ordinary artisan to make the modifications that the Examiner believes “would be obvious.”

Undeniably, a *prima facie* case of obviousness cannot be established by simply asserting that a recited feature is obvious. Rather, the Examiner’s unsupported allegation of obviousness suggests that the Examiner has, at best, used the teachings of the application as a road map to reach the instant claims. The Federal Circuit has warned that the Examiner must not “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *In re Dembiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)). Avoiding hindsight reconstruction is especially important regarding less technologically complex inventions, where the very ease with which the invention can be understood may prompt one to employ such hindsight. *See id.*

Therefore, without any proper supporting *evidence*, the Examiner's summary statement regarding what "would have been obvious" is, again at best, impermissible hindsight reconstruction.

Because the Examiner has not demonstrated a *prima facie* case of obviousness, Appellant is not required to submit any argument or evidence to rebut such a showing. However, even if the Examiner had demonstrated a *prima facie* case of obviousness, the appropriate legal precedent holds that an alleged duplication of part is *not* obvious if a new and unexpected result is produced. *See In re Harza*, 124 U.S.P.Q. 378, 380 (C.C.P.A. 1960); M.P.E.P. §2144.04(VI)(B). With regard to the instant application, the Examiner has ignored a number of advantages that the claimed invention presents over the device of the Ohgami reference. For example, a plurality of bosses, as recited in independent claims 1, 20, and 29 provides additional stability to the claimed component mount in comparison to the battery module disclosed in the Ohgami reference. Specifically, the *plurality* of bosses on the component mount supports lifting of the component mount at two or more points thereby improving stability. This enables lifting of the component mount in a smooth and consistent manner such that the module does not tend to tip, cock, or bind as it is repeatedly inserted and removed. Furthermore, the employment of a plurality of bosses also decreases the amount of lifting force applied to each boss because the weight of the component is distributed among the plurality of bosses. This distribution of weight also improves the sliding motion of the component. Appellant further notes that these are but some of the advantages of the claimed invention over the device of the Ohgami reference. Clearly, the claimed invention presents new and unexpected results in comparison to the device of the cited reference, and, as such, is not an obvious "duplication of parts."

In closing, Appellant reminds the Board again that the Examiner bears the burden of establishing a *prima facie* case of obviousness. With that in mind, Appellant respectfully asserts that the foregoing remarks clearly establish that the Examiner has failed to satisfy the evidentiary thresholds. Indeed, conclusory statements can simply not satisfy the Examiner's burden. Accordingly, Appellant respectfully asserts that independent claims 1, 20, and 29, and the claims that depend therefrom, are patentable over the cited reference and in condition for allowance. As such, in light of the foregoing remarks, Appellants respectfully request

that the Board withdraw the obviousness rejections in relation to claims 1-6, 20-21, 29-32, 33-35, 38-39, and 41-42. Additionally, Appellants respectfully request that the Board direct the Examiner to allow these claims.

3. **The Examiner's rejection of dependent claim 2 is improper because the rejection fails to establish a prima facie case of obviousness.**

Dependent claim 2 recites:

The component mount of claim 1, wherein the retention structure and the mating retention structure comprises angled abutment surfaces

In rejecting dependent claim 2, the Examiner asserted that the Ohgami reference discloses or suggested all of the recited features of the claim. *See* Final Office Action mailed February 1, 2005, page 6. Appellant respectfully traverses this assertion. As discussed above, the present application is directed towards a technique that facilitates the insertion and removal of a battery module from an electronic device. Page, 3, lines 14-16. Accordingly, dependent claim 2 recites a component mount for a computer "wherein the retention structure and the mating retention structure comprises *angled abutment surfaces*." (Emphasis added). As summarized above with respect to the improper rejection of claim 7, the arguments for which are incorporated herein by reference, the Ohgami reference does not disclose or suggest the above-recited claim features of dependent claim 2.

Because the reference fails to disclose each element recited by the instant claim, the Ohgami reference fails to anticipate dependent claim 2. Thus, the Examiner's rejection of dependent claim 2, and the claims depending therefrom, is clearly improper. Accordingly, Appellant requests that the Board overturn the rejection and allow dependent claim 2 and the claims that depend from it.

4. **The Examiner's rejection of dependent claim 4 is improper because the rejection fails to establish a prima facie case of obviousness.**

Dependent claim 4 recites:

The component mount of claim 2, wherein the angled abutment surfaces are substantially parallel to one another and are substantially perpendicular to a direction of movement between the retention structure and the mating retention structure.

In rejecting dependent claim 4, the Examiner asserted that the Ohgami reference discloses or suggested all of the recited features of the claim. *See* Final Office Action mailed February 1, 2005, page 6. Appellant respectfully traverses this assertion. As discussed above, the present application is directed towards a technique that facilitates the insertion and removal of a battery module from an electronic device. Page, 3, lines 14-16. Accordingly, dependent claim 4 recites a component mount for a computer “wherein the angled abutment surfaces are *substantially parallel* to one another and are *substantially perpendicular* to a direction of movement.” (Emphasis added). As summarized above with respect to the improper rejection of claim 10, the arguments for which are incorporated herein by reference, the Ohgami reference does not disclose or suggest the above-recited claim features of dependent claim 4.

Because the reference fails to disclose each element recited by the instant claim, the Ohgami reference fails to anticipate dependent claim 4. Thus, the Examiner’s rejection of dependent claim 4, and the claims depending therefrom, is clearly improper. Accordingly, Appellant requests that the Board overturn the rejection and allow dependent claim 2 and the claims that depend from it.

5. The Examiner’s rejection of dependent claim 39 is improper because the rejection fails to establish a prima facie case of obviousness.

Dependent claim 39 recites:

The component mount of claim 20, wherein the retention structures comprise angled retention structures.

In rejecting dependent claim 39, the Examiner asserted that the Ohgami reference discloses or suggested all of the recited features of the claim. *See* Final Office Action mailed February 1, 2005, page 7. Appellant respectfully traverses this assertion.

As discussed above, the present application is directed towards a technique that facilitates the insertion and removal of a battery module from an electronic device. Page, 3, lines 14-16. Accordingly, dependent claim 41 recites a component mount “wherein the retention structures comprise *angled* retention structures.” (Emphasis added). As summarized above with respect to the improper rejection of claim 7, the arguments for which are incorporated herein by reference, the Ohgami reference does not disclose or suggest the above-recited claim features of dependent claim 39.

Because the reference fails to disclose each element recited by the instant claim, the Ohgami reference fails to anticipate dependent claim 39. Thus, the Examiner’s rejection of dependent claim 39, and the claims depending therefrom, is clearly improper. Accordingly, Appellant requests that the Board overturn the rejection and allow dependent claim 39 and the claims that depend from it.

6. **The Examiner’s rejection of dependent claim 41 is improper because the rejection fails to establish a prima facie case of obviousness.**

Dependent claim 41 recites:

The component mount of claim 29, wherein the retention structures comprise angled retention structures.

In rejecting dependent claim 41, the Examiner asserted that the Ohgami reference discloses or suggested all of the recited features of the claim. *See* Final Office Action mailed February 1, 2005, page 8. Appellant respectfully traverses this assertion. As discussed above, the present application is directed towards a technique that facilitates the insertion and removal of a battery module from an electronic device. Page, 3, lines 14-16. Accordingly, dependent claim 41 recites a component mount “retention structures comprise *angled* retention structures.” (Emphasis added). As summarized above with respect to the improper rejection of claim 7, the arguments for which are incorporated herein by reference, the Ohgami reference does not disclose or suggest the above-recited claim features of dependent claim 41.

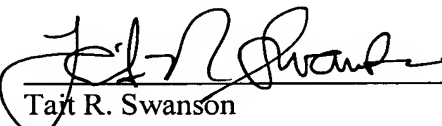
Because the reference fails to disclose each element recited by the instant claim, the Ohgami reference fails to anticipate dependent claim 41. Thus, the Examiner's rejection of dependent claim 41, and the claims depending therefrom, is clearly improper. Accordingly, Appellant requests that the Board overturn the rejection and allow dependent claim 41 and the claims that depend from it.

Conclusion

Appellants respectfully submit that all pending claims are in condition for allowance. However, if the Examiner or Board wishes to resolve any other issues by way of a telephone conference, the Examiner or Board is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

Date: May 27, 2005


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8. **APPENDIX OF CLAIMS ON APPEAL**

Listing of Claims:

1. A component mount for a computer, comprising:
 - a component latch movable between a latched configuration and an unlatched configuration;
 - a plurality of bosses; and
 - a lifter engageable with the plurality of bosses to move a component to a lifted position in the unlatched configuration, wherein the plurality of bosses comprise a retention structure retainable against a mating retention structure of the lifter to retain the component in the lifted position.
2. The component mount of claim 1, wherein the retention structure and the mating retention structure comprises angled abutment surfaces.
3. The component mount of claim 2, wherein the angled abutment surfaces comprise a notch and a tab.
4. The component mount of claim 2, wherein the angled abutment surfaces are substantially parallel to one another and are substantially perpendicular to a direction of movement between the retention structure and the mating retention structure.
5. The component mount of claim 1, wherein the lifter comprises at least one angled surface leading to the mating retention structure.
6. The component mount of claim 5, wherein the plurality of bosses comprise a curved engagement surface disposed against the at least one angled surface.
7. A component mount for a computer, comprising:
 - a component latch movable between a latched configuration and an unlatched configuration;

a lifter having a sloped structure leading to an inwardly angled structure; and
a boss movable along the sloped structure to a lifted position at the inwardly
angled structure, whereat a mating angled structure of the boss is
retainable against the inwardly angled structure.

8. The component mount of claim 7, wherein the inwardly angled structure comprises
a notch.

9. The component mount of claim 7, wherein the mating angled structure comprises
an outwardly extending tab.

10. The component mount of claim 7, wherein the inwardly angled structure and the
mating angled structure comprise substantially flat abutment surfaces that are substantially
angled relative to a direction of movement between the inwardly angled structure and the
mating angled structure.

11. The component mount of claim 7, wherein the boss comprises a curved
engagement surface disposed against the sloped structure.

12. The component mount of claim 7, comprising at least one additional lifter and at
least one additional boss, which is movable by the at least one additional lifter to the lifted
position.

13. The component mount of claim 12, wherein the least one additional lifter and the
at least one additional boss comprise retention structures, which are retainable against one
another at the lifted position.

14. A removable computer component, comprising:

a component housing insertable into a receptacle of a computer chassis; and
a component mount at least partially disposed on the component housing and
at least partially mountable in the computer chassis, the component
mount comprising:

a component latch movable between a latched configuration and an unlatched configuration;
a lifter having a sloped structure leading to an angled retention structure; and
a boss movable along the sloped structure to a lifted position at the angled retention structure, whereat a mating angled structure of the boss is retainable against the angled retention structure.

15. The removable computer component of claim 14, wherein the component housing comprises a battery module.

16. The removable computer component of claim 14, wherein one of the angled retention structure and the mating angled structure comprises a notch, and a mating one of the angled retention structure and the mating angled structure comprises an outwardly extending tab.

17. The removable computer component of claim 14, wherein the angled retention structure and the mating angled structure comprise substantially parallel abutment surfaces.

18. The removable computer component of claim 14, comprising at least one additional lifter and at least one additional boss, which is movable by the at least one additional lifter to the lifted position.

19. The removable computer component of claim 18, wherein the least one additional lifter and the at least one additional boss comprise retention structures, which are retainable against one another at the lifted position.

20. A removable computer component, comprising:

a component housing insertable into a receptacle of a computer chassis; and

a component mount at least partially disposed on the component housing and at least partially mountable in the computer chassis, the component mount comprising:

- a latching mechanism movable to latch and unlatch the component housing with the receptacle; and
- a plurality of bosses movable by a lifting mechanism to move the component housing to a lifted position, whereat retention structures are engageable to support the component housing in the lifted position.

21. The removable computer component of claim 20, wherein the component housing comprises a battery module.

22. A computer chassis, comprising:

- a recessed structure adapted to receive a computer component;
- a component mount at least partially positioned in the recessed structure and at least partially mountable to the computer component, the component mount comprising:
 - a component latch movable between a latched configuration and an unlatched configuration;
 - a lifter having a sloped structure leading to an angled retention structure; and
 - a boss movable along the sloped structure to a lifted position at the angled retention structure, whereat a mating angled structure of the boss is retainable against the angled retention structure.

23. The computer chassis of claim 22, wherein the recessed structure is disposed within a portable computer housing.

24. The computer chassis of claim 22, comprising a motherboard and a processor mounted to the motherboard.

25. The computer chassis of claim 22, comprising a display coupled to a component housing having the recessed structure.

26. The computer chassis of claim 22, wherein the recessed structure comprises battery connectors engageable with mating connectors of the computer component.

27. The computer chassis of claim 22, wherein one of the angled retention structure and the mating angled structure comprises a notch, and a mating one of the angled retention structure and the mating angled structure comprises an outwardly extending tab.

28. The computer chassis of claim 22, comprising at least one additional lifter and at least one additional boss, which is movable by the at least one additional lifter to the lifted position.

29. A computer chassis, comprising:

- a recessed structure adapted to receive a computer component;

- a component mount at least partially positioned in the recessed structure and at least partially mountable to the computer component, the component mount comprising:

- a latching mechanism adapted to latch and unlatch the computer component with the recessed structure; and

- a plurality of bosses movable by a lifting mechanism to move the component housing to a lifted position, whereat retention structures are engageable to support the component housing in the lifted position.

30. The computer chassis of claim 29, wherein the recessed structure is disposed within a portable housing having a panel display.

31. The computer chassis of claim 29, wherein the recessed structure comprises battery connectors engageable with mating connectors of the computer component.

32. The computer chassis of claim 29, wherein the retention structures comprise a notch and an outwardly extending tab.

33. The component mount of claim 1, wherein the mating retention structure of the lifter is configured to block movement of the plurality of bosses from the lifted position to a recessed position.

34. The component mount of claim 1, wherein the lifter comprises a plurality of lift tabs.

35. The component mount of claim 34, wherein one of the plurality of lift tabs comprises a substantially flat recessed surface, which is configured to support one of the plurality of bosses when the component is in the lifted position

36. The component mount of claim 7, wherein the inwardly angled structure of the lifter is configured to block movement of the boss from the lifted position to a recessed position.

37. The component mount of claim 14, wherein the angled retention structure of the lifter is configured to block movement of the boss from the lifted position to a recessed position.

38. The component mount of claim 20, wherein the retention structures are configured to block movement of the plurality of bosses from the lifted position to a recessed position.

39. The component mount of claim 20, wherein the retention structures comprise angled retention structures.

40. The component mount of claim 22, wherein the angled retention structure of the lifter is configured to block movement of the boss from a lifted position to a recessed position.

41. The component mount of claim 29, wherein the retention structures comprise angled retention structures.

42. The component mount of claim 29, wherein the retention structures are configured to block movement of the plurality of bosses from the lifted position to a recessed position.